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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,957	12/18/2001	Wayne M. Doran	9852.00	7152
26889	7590	06/04/2007		
MICHAEL CHAN NCR CORPORATION 1700 SOUTH PATTERSON BLVD DAYTON, OH 45479-0001			EXAMINER WINTER, JOHN M	
			ART UNIT	PAPER NUMBER
			3621	
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			06/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/022,957

Applicant(s)

DORAN, WAYNE M.

Examiner

John M. Winter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 48-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 48-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Acknowledgements

The Applicants amendment filed on March 26, 2007 is acknowledged, Claims 22-26,28 and 38-47 have been canceled. Claims 48-62 are pending.

Response to Arguments

The Applicants arguments filed on March 26, 2007 have been fully considered.

The Applicant states that the claimed feature of "validation number yet to be generated and then associated with a check to be presented from the check payor to a check payee" is not disclosed by the prior art references.

The Examiner responds that as the validation number is yet to be generated, this is not a postive claim limitation, since events in the future exist only in abstract form, and therefore the database disclosed by Chang meets the limitations of the claimed feature.

In response to applicant's argument that Chang et al. (US Patent 5,884,288) in view of Bozeman (US Patent 6,754,640) and in further view of Talati et al. (US Patent 5,903,878) is nonanalogous art, it has been held that a prior art reference must either be in the field of

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applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

See following rejection .

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 48-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al. (US Patent 5,884,288) in view of Bozeman (US Patent 6,754,640) and in further view of Talati et al. (US Patent 5,903,878).

As per claim 51,

Chang et al. ('288) discloses a computer implemented method by a financial institution, the method comprising, by a server associated with the financial institution:

receiving from a check payor a request for a validation number yet to be generated and then associated with a check to be presented from the check payor to a check payee; (Figure 6 [bill payment database contains validation numbers, Examiner notes that the feature of "yet to be determined is not a positive claim limitation since events in the future are not tangible])

Chang et al. ('288) does not explicitly disclose determining if an account contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee; Bozeman ('640) discloses determining if an account contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee; (Column 12, lines 7-19 [..checks for sufficient funds..]) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Chang et al. ('288) method with the Bozeman ('640) method in order to prevent illegal transactions from occurring.

Chang et al. ('288) does not explicitly disclose issuing the generated validation number to the check payor to allow the check payor to associate the generated validation number with the check to be presented to the check payee; Talati et al. ('878) discloses issuing the generated validation number to the check payor to allow the check payor to associate the generated validation number with the check to be presented to the check payee; (Column 7, lines 25-63) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Chang et al. ('288) method with the Talati et al. ('878) method in order to prevent illegal transactions from occurring by validating the transaction with the originating party..

Chang et al. ('288) does not explicitly disclose generating a validation number when the account contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee; Talati et al. ('878) discloses generating a validation number when the account contains sufficient funds to cover the monetary amount of the check to be presented from the check payor to the check payee; (Column 7, line 45 – column 8, line 16) It would be obvious to one having ordinary skill in the art at the time the invention was made to

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combine the Chang et al. ('288). method with the Talati et al. ('878) method in order to prevent illegal transactions from occurring by validating the transaction with the originating party..

Claims 48, 49, 53, 54, 57, 58, 59 and 61 are in parallel with claim 51 and are rejected for at least the same reasons.

In regards to claims 54 and 57

Chang et al. ('288) does not explicitly disclose means for establishing a proposed character sequence for the check; means for transmitting the proposed character sequence to the first requestor over the internet; Talati et al. ('878) discloses means for establishing a proposed character sequence for the check; means for transmitting the proposed character sequence to the first requestor over the internet; (Column 7, lines 25-63) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Chang et al. ('288). method with the Talati et al. ('878) method in order to prevent illegal transactions from occurring by validating the transaction with the originating party..

As per claim 50,

Chang et al. ('288) discloses a computer implemented method according to claim 23, wherein the at least some information associated with the check comprises:

Chang et al. ('288) does not explicitly disclose a date of the check; a serial number of the check; an account number of the account; a monetary amount of the check; a payee of the check; symbols identifying a drawee financial institution which maintains custody of the account; and a Uniform Resource Locator (URL). Talati et al. ('878) discloses a date of the check; a serial

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number of the check; an account number of the account; a monetary amount of the check; a payee of the check; symbols identifying a drawee financial institution which maintains custody of the account; and a Uniform Resource Locator (URL). (Column 7, lines 25-44) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Chang et al. ('288). method with the Talati et al. ('878) method in order to prevent illegal transactions from occurring by validating the transaction with the originating party..

Claim 60 is in parallel with claim 24 and is rejected for at least the same reasons.

As per claim 52,

Chang et al. ('288) discloses a computer implemented method according to claim 51,

Chang et al. ('288) does not explicitly disclose wherein allocating funds comprises deducting the monetary amount from the account. Talati et al. ('878) discloses allocating funds comprises deducting the monetary amount from the account. (Column 7, line 64 – column 8 line 16) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Chang et al. ('288). method with the Talati et al. ('878) method in order to profit from the transaction.

Claim 62 is in parallel with claim 52 and is rejected for at least the same reasons.

As per claim 55,

Chang et al. ('288) discloses a system according to claim 54,

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Official Notice is taken that “ the validation number is randomly generated by a financial institution” is common and well known in prior art in reference to security protocols. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a random number in order to prevent transaction information from being associated with a customer’s account, the Examiner notes that the usage of random numbers is common to many cryptography systems.

As per claim 56,

Chang et al. ('288) discloses a system according to claim 54,

Chang et al. ('288) does not explicitly disclose wherein the validation number is derived using at least some information associated with the check.; Talati et al. ('878) discloses wherein the validation number is derived using at least some information associated with the check. (Column 7, lines 25-63) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Chang et al. ('288). method with the Talati et al. ('878) method in order to prevent illegal transactions from occurring by validating the transaction with the originating party..

Conclusion

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is

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respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Also in accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that Nathan J. Muller's Desktop Encyclopedia of the Internet, ("Desktop Encyclopedia") is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Muller's Desktop Encyclopedia is a practical reference that clearly explains Internet services, applications, protocols, access methods, development tools, administration and management, standards, and regulations. Because of the reference's basic content (which is self-evident upon examination of the reference) and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that the Desktop Encyclopedia is primarily directed towards those of low skill in this art. Because the reference is directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within the Desktop Encyclopedia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Winter whose telephone number is (571) 272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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